

### **REMARKS**

Claims 1-40 were pending and presented for examination. In an Office Action dated August 8, 2006, claims 1-40 were rejected. Applicants thank Examiner for examination of the claims pending in this application and address Examiner's comments below.

Applicants have amended the specification to add serial numbers. Applicants have amended claims 1, 4, 7, 16, 25, 31, 32, and 40; canceled claims 2, 19-24, 26-30; and added new claims 41-44. In view of the Amendments herein and the Remarks that follow, Applicants respectfully request that Examiner reconsider all outstanding objections and rejections, and withdraw them.

Claims 1-40 are now present in this case. Consideration of the application in view of the following remarks is respectfully requested.

Claims 1-3, 9-12, 16, 18-28, 30, 31, and 40 were rejected under 35 USC § 102(e) as allegedly being anticipated by Reber (U.S. Patent No. 6,138,151). Additionally, claims 32-36 were rejected under § 102(e) as allegedly being anticipated by Matsubayashi (U.S. Patent No. 6,938,202); claims 4-7 were rejected under 35 U.S.C. § 103 as being unpatentable over Reber in view of Owen (U.S. Patent No. 7,075,676); claims 8, 13-15, 17, and 29 were rejected under 35 U.S.C. § 103 as being unpatentable over Reber in view of Dutta (US 2002/0135800); and claims 37-39 were rejected under 35 U.S.C. § 103 as being unpatentable over Matsubayashi in view of Reber.

#### Response to Rejections Under 35 USC 102(e)

Independent claim 1 as amended recites “retrieving, by the printer, the data pointed to by the pointer” and “creating by the printer, *in response to retrieval of the data*, a printable document comprising at least a portion of the retrieved data.”

Thus, the invention of claim 1 retrieves data pointed to by a pointer in a received document and incorporates it into a printable document.

Reber, in contrast, first generates a code representing an electronic address associated with an article and then prints the article along with the generated code. Thus, people reading the article can go to the address associated with the article. For example, if the article has an associated web page, a code representing the URL of the web page will be printed with the article. Reber fails to disclose or suggest a printer that retrieves the data pointed to by a pointer prior to printing it. Reber Figure 2 and the corresponding text from column 6, line 66 to column 7, line 18 describe the making of a printed publication but disclose only communicating a plurality of electronic addresses, receiving back a plurality of associated codes, and printing the

publication with the plurality of codes. There is absolutely no disclosure of retrieving the data pointed to by the pointer in a received document; and creating by the printer, in response to retrieval of the data, a printable document comprising at least a portion of the retrieved data.

As discussed above, Reber fails to disclose retrieving the data pointed to by the pointer. Reber column 6, lines 16-30, discloses the publisher terminal communicating electronic addresses to a node, the node generating codes associated with the electronic addresses, storing those codes in a database, and communicating the codes back to the publisher terminal, but makes no reference to retrieving the data pointed to by the addresses / pointers.

Thus, Reber fails to anticipate claim 1 for at least these reasons.

Similarly, independent claim 40 as amended recites “means for retrieving the data pointed to by the pointer” and “means for creating by the printer, *in response to retrieval of the data*, a printable document containing at least a portion of the data pointed to by the pointer.”

Thus, claim 40, like claim 1, specifically recites that the printer has the capability of “retrieving the data pointed to by the pointer,” something that Reber fails to disclose. Therefore, Reber likewise fails to anticipate claim 40.

Independent claim 25 as amended recites, “receiving by a printer a document containing multimedia information” and “storing by the printer at least some of the multimedia information in a database.” By contrast, in Reber the printer (“publisher terminal”) receives only a list of codes, and does not receive multimedia data such as audio, video, or the like. Further, in Reber the computer that generates the codes and transmits them to the printer is the one to store the information in the database, not the printer itself; the Reber printer merely receives the codes and prints them along

with the articles. See Reber Figure 3; col 6 lines 17-29 (“The computer 56 stores in the database 54 translation information associating the codes with the electronic addresses”). In particular, the cited portion of Reber (col 5, lines 18-25) merely discloses the computer (not the printer) *looking up* the code in the existing database; this has nothing to do with *storing* the multimedia information in the database. Thus, Reber fails to disclose or suggest claim 25.

Independent claim 31 as amended recites, “creating by the printer, in response to receipt of the document, a printable document in accordance with the multimedia information and including at least one frame grab of video data in accordance with the multimedia information.” Thus, it is the *printer* that receives the multimedia content and creates a printable document including a frame grab of video data. In contrast, in Reber it is the *user*, not the printer, that receives the data discussed in Reber col 9, lines 13-24: see Reber col 5, lines 57-67 (“By linking to the electronic address, the end user 50 can... By communicating data to the electronic address, the end user 50 can... By receiving data from the electronic address, the end user 50 can...”.) Further, there is no suggestion in Reber of grabbing a frame of video data from the multimedia data. Thus, Reber fails to anticipate claim 31.

Independent claim 32 as amended recites:

32. A method performed by a printer, comprising:  
*without being prompted by a manual user interface request*, gathering  
information about multimedia data that is accessible to  
the printer; and  
creating a summary of the accessible multimedia data.

Independent claim 32 as amended recites that the invention gathers information about multimedia data even when the user has not explicitly so requested via a user interface. Matsubayashi, in contrast, involves a system wherein the user must manually enter a URL in order to view the files at that location. See,

e.g., Matsubayashi Figures 9-11, illustrating the contents of a directory being listed in a browser responsive to the user manually entering the URL for that machine and directory into a web page input field. Thus, the claimed invention beneficially provides the ability to gather information either automatically or in response to a command encoded within a received document, which is not disclosed in Matsubayashi. Thus, Matsubayashi fails to anticipate claim 32.

As for the dependent claims, claims 2-18 and 33-39 depend from claims 1 and 32, respectively, and recite additional features and limitations. Thus, all arguments advanced above with respect to claims 1 and 32 are hereby incorporated so as to apply to claims 2-18 and 33-39.

#### Response to Rejections Under 35 USC 103(a)

As to claims 4-7 (dependent on claim 1), Owen fails to cure the deficiencies of Reber. Owen merely discloses a method for including a barcode related to a document as part of a print job; it does not teach, disclose, or suggest receiving a document having a pointer to data that is not in the received document, retrieving the data pointed to by the pointer, creating a printable document comprising at least a portion of the retrieved data, or the printable document including both the data that is not in the received document and the pointer.

As to claims 8, 13-15, and 17 (dependent on claim 1), Dutta fails to cure the deficiencies of Reber. Dutta merely discloses parsing a web-based document and changing its structure so as to conserve print resources; it does not teach, disclose, or suggest receiving a document having a pointer to data that is not in the received document, retrieving the data pointed to by the pointer, or creating a printable document comprising at least a portion of the retrieved data.

As to claims 37-39 (dependent on claim 32), Reber fails to cure the deficiencies of Matsubayashi. Reber involves generating a code representing an electronic address associated with an article and printing the article along with the generated code; it does not teach, disclose, or suggest gathering information about multimedia data even when the user has not explicitly so requested via a user interface. Further, Reber does not teach, disclose, or suggest creating a summary of accessible multimedia data; rather, Reber col. 9 lines 13-24 discloses the transfer of the entire content available at the destination, not a summary thereof.

### CONCLUSION

In sum, Applicants respectfully submit that claims 1-44 are patentably distinguishable over the cited references. Therefore, Applicants request their allowance.

On the basis of the above amendment and remarks, consideration of this application and the early allowance of all claims herein are requested.

Should the Examiner wish to discuss the above remarks, or if the Examiner believes that for any reason direct contact with Applicants' representative would help to advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,  
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